

REMARKS:

Claims 5, 6, 10-13, and 16-19 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,918,217 (Maggioncalda). In response, Applicant contends for the following reasons that the rejected claims are patentable over the cited reference.

Claim 5 recites a processor programmed to perform an arithmetic performance attribution computation of a specifically recited type, including by determining coefficients $(A + \alpha_i)$ of the specifically recited type, and determining portfolio relative performance in a specifically recited way using these coefficients.

Claim 6 recites a computer readable medium which stores code for programming a processor to perform an arithmetic performance attribution computation of a specifically recited type, including by determining coefficients $(A + \alpha_i)$ of the specifically recited type, and determining portfolio relative performance in a specifically recited way using these coefficients.

Claim 10 recites a processor programmed to perform a geometric performance attribution computation of a specifically recited type, including by determining attribution effects for issue selection $(1 + I_{ii}^G)$ of the specifically recited type, determining attribution effects for sector selection $(1 + S_{ii}^G)$ of the specifically recited type, and determining portfolio performance in a specifically recited way using these attribution effects.

Claim 12 recites a computer readable medium which stores code for programming a processor to perform a geometric performance attribution computation of a specifically recited type, including by determining attribution effects for issue selection $(1 + I_{ii}^G)$ of the specifically recited type, determining attribution effects for sector selection $(1 + S_{ii}^G)$ of the specifically recited type, and determining portfolio performance in a specifically recited way using these attribution effects.

Claim 16 recites a processor programmed to perform a geometric performance attribution computation of a specifically recited type, including by determining

attribution effects $1 + Q_{ij}^G$ of the specifically recited type and determining portfolio performance in a specifically recited way using these attribution effects.

Claim 18 recites a computer readable medium which stores code for programming a processor to perform a geometric performance attribution computation of a specifically recited type, including by determining attribution effects $1 + Q_{ij}^G$ of the specifically recited type and determining portfolio performance in a specifically recited way using these attribution effects.

Maggioncalda fails to teach or suggest a processor programmed to perform any arithmetic or geometric performance attribution computation, and fails to teach or suggest a processor programmed to perform the operations specifically recited in claim 5, 10 or 16. Maggioncalda also fails to teach or suggest a computer readable medium which stores code for programming a processor to perform any arithmetic or geometric performance attribution computation, and fails to teach or suggest a computer readable medium which stores code of the type specifically recited in claim 6, 12, or 18.

The assertion on page 3 of the Office Action that the “claimed invention recites an intended use” (of an unspecified item) is incorrect to the extent that it implies that claim 5, 10, or 16 reads on a computer system including a processor (e.g., an unprogrammed processor) that is not programmed to perform the recited operations but is capable of being programmed to perform such operations, and a display device coupled to the processor. Such broad construction of claims 5, 10, and 16 is overbroad since it ignores the explicit limitation in each of claims 5, 10 and 16 of a processor that has been programmed to perform specifically recited operations. None of claims 5, 10, and 16 is intended to read on a computer system that does not include a processor programmed as recited.

The assertion on page 3 of the Office Action that the “claimed invention recites an intended use” (of an unspecified item) is also incorrect to the extent that it implies that claim 6, 12, or 18 reads on a computer readable medium which does not

store code for programming a processor to perform the recited performance attribution computation but is capable of storing such code. Such broad construction of claims 6, 12, and 18 is overbroad since it ignores the explicit limitation in each of these claims of a computer readable medium that does store code of the specifically recited type. None of claims 6, 12, and 18 is intended to read on a computer readable medium that does not store code of the specifically recited type.

Applicant also contends that the rule (cited in the Office Action) that “recitation of a new intended use for an old product does not make a claim to that old product patentable” does not provide a basis for rejecting any of the claims. None of the rejected claims is directed to an “old” product or recites a new use for an old product. Rather, each of the rejected claims recites a new product (namely, a computer system including a processor that has been programmed in a new way, or a computer readable medium that stores code of a new type). A programmable processor (e.g., the CPU of a personal computer) has a physically different state when it has been programmed as recited in claim 5, 10, or 16, than when it has not been so programmed. Thus, the recited processor is a new product because it has been so programmed (in contrast with an “old” processor that has a different physical state than the recited processor because it has not been so programmed). Similarly, a computer readable medium that stores code of a specific type has a physically different state than when it does not store such code. Thus, the computer readable medium recited in each of claims 6, 12, and 18 is a new product because it stores such code (in contrast with an “old” medium that has a different physical state than the recited medium because it does not store the recited code).

Applicant respectfully contends that the assertion in the Office Action that Maggioncalda discloses (e.g., at column 6, lines 25-42) a processor “programmed to perform an arithmetic performance attribution computation to determine portfolio performance” is incorrect. There is no teaching determinable from Maggioncalda, at column 6, lines 25-55, or elsewhere, of a processor programmed to perform such an operation or that it would be desirable to so program a processor. The only teachings in Maggioncalda regarding how to program a processor are teachings to program a processor to perform operations very different from those recited in any of claims 5 and 6. For example, Maggioncalda teaches programming a processor to perform

computations such as determining a recommended set of financial products (e.g., the products indicated in region 430 of Maggioncalda's Fig. 4) for achieving user-specified financial goals, and "constraining settings associated with... [a] graphical input mechanism" in response to a user-specified "desired level of investment risk," and determining an indication (e.g., the indications shown in Maggioncalda's Fig. 7c) of the probability of achieving a user-specified financial goal. There is no teaching or suggestion determinable from Maggioncalda of a processor programmed to perform the specific operations recited in claim 5 or of a computer readable medium that stores code of the type specifically recited in claim 6.

Nor is there a basis determinable from a reference of record for the assertion in the Office Action that Maggioncalda's computer system is "capable of performing an arithmetic performance attribution computation" of the type recited in claim 5 or 6. Rather, this assertion is incorrect. In order for Maggioncalda's computer system to have the asserted capability, the processor of such system would need to be programmed or otherwise configured to perform the arithmetic performance attribution computation. Maggioncalda fails to teach or suggest how to so program or configure a processor, or that it would be desirable to so program or configure a processor. Absent teaching determinable from art of record to program a processor to perform the operations recited in claim 5 or 6, it is improper to reject claim 5 or 6 on the basis of an unsupported assertion that "it would have been obvious" to program Maggioncalda's processor to perform such operations.

Further, even assuming for the sake of argument that Maggioncalda's computer system is capable of performing an arithmetic performance attribution computation (if programmed to do so), there is no basis determinable from Maggioncalda for rejecting claim 10, 12, 16, or 18 since each of these claims recites a processor programmed to perform a geometric performance attribution computation (i.e., the specifically recited geometric performance attribution computation) or a computer readable medium that stores code for so programming a processor.

The Office Action identifies no teaching or suggestion determinable from Maggioncalda or any other reference of record that Maggioncalda's computer system is capable of performing a geometric performance attribution computation of the type

recited in claim 10, 12, 16, or 18. In fact, neither Maggioncalda nor any other reference of record includes such teaching or suggestion. In order for Maggioncalda's computer system to have this capability, the processor of such system would need to be programmed or otherwise configured to perform the recited geometric performance attribution computation. Maggioncalda fails to teach or suggest how to so program or configure a processor, or that it would be desirable to so program or configure a processor.

Further, even assuming for the sake of argument that Maggioncalda's computer system is capable of performing an arithmetic performance attribution computation (if programmed to do so), there is no basis determinable from Maggioncalda for rejecting claim 5, 6, 10, 12, 16, or 18, since each of these claims recites a processor programmed to perform an arithmetic or geometric performance attribution computation of a specifically recited type (or a medium which stores code for so programming a processor) and Maggioncalda neither teaches nor suggests programming a processor to perform this specifically recited computation. The Examiner has not identified any such specific teaching or suggestion in Maggioncalda, and instead apparently relies improperly on the unsupported assertion that it "would have been obvious" to program Maggioncalda's processor to perform the recited operation.

For the reasons set forth herein, reconsideration and allowance of claims 5, 6, 10, 12, 16, and 18 (and each claim that depends directly or indirectly from any of these claims) is respectfully requested.

Respectfully submitted,

GIRARD & EQUITZ LLP

Dated: 8/12/05 By: Alfred A. Equitz
Alfred A. Equitz
Reg. No. 30,922

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Attorneys for Applicant(s)